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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,888	03/22/2004	Robert William Winter	51432/RRT/A784	2212

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EXAMINER

MYINT, DENNIS Y

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/805,888	WINTER, ROBERT WILLIAM	
	Examiner	Art Unit	
	Dennis Myint	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>22 March 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-40 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2, 28 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b) states that "a claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts".

MPEP 2106.II.A states that "***a process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994)***".

Claims 1 and 28 in view of the above-cited MPEP sections are not statutory because they merely recite a number of computing steps *without producing any tangible results and/or being limited to practical application within the technological arts*. The claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a)

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refers to "computer-readable" medium with computer program encoded on it."

Claim 2 and 29 are rejected under 35 U.S.C. 101 because of their dependency on claim 1 and 28 respectively.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-6, 19-23, 28-33, and 38-40 rejected under 35 U.S.C. 102(e) as being anticipated by Covington JR et al., (hereinafter "Covington") (U.S. Patent Application Publication Number 2003/0009448).

As per claim 1 Covington is directed to a method for identifying content in a computer network (Paragraph 0001) and teaches the limitations:

"storing a plurality of predetermined categories in a database" (Paragraph 0047, i.e., *In one embodiment of the invention, Database Reviewer **adds additional categories***);

"categorizing a plurality of items corresponding to one or more of the plurality of predetermined categories, by a plurality of categorizers, respectively" (Paragraph 0047, i.e., *the Database Reviewers may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information.*; and Paragraph 0047, i.e., *In one embodiment of the invention, Database Reviewer*

adds additional categories and structures to the proposed database prior to adding the new information to the database);

“selecting a category from the plurality of predetermined categories” (Paragraph 0010, i.e., *Next the system associates the inquiry with one or more predefined categories and provides one more possible responses to the inquiry based on the available information*);

“selecting a categorizer from the plurality of categorizers” (Paragraph 0008, i.e., *a response to the User’s inquiry is forwarded by the system to an expert specifically designated by the user*; Paragraph 0021, i.e., *In an embodiment where the expert is associated with the User*; Paragraph 0030, *Such an expert can be a person designated either by the customer or by the service provider*, and Paragraph 0021, i.e., *In addition, the customer can specify that certain User’s should be answered only by the Expert*) ;
and

“ initiating a search for one or more items in the computer network corresponding to the selected category and the selected categorizer” (Paragraph 0021, i.e., *In addition, the customer can specify that certain User’s should be answered only by the Expert*; Paragraph 0010, i.e., *Next the system associates the inquiry with one or more predefined categories and provides one more possible responses to the inquiry based on the available information*; and Paragraph 0022, i.e., *after reviewing the User’s profile in step 1300 the system searches the available database for categories identified in step 1200*).

As per claim 2, Covington teaches the limitation:

“further comprising signing up on a web site as an authorized user” (Paragraph 0017, i.e., *a User can be an employee of the customer, and the customer can be the **subscribing party***; Paragraph 0020, i.e., *the system would retrieve the User’s profile from a database*).

As per claim 3, Covington teaches the limitation:

“further comprising displaying results of the search on a display” (Paragraph 0029, i.e., *Returning to Fig. 1, if after viewing the potential responses to the inquiry, the user is still not satisfied*).

As per claim 4, Covington teaches the limitation:

“further comprising ordering the displayed search results based on a user selectable order” (Paragraph 0023, i.e., *In another embodiment of the invention the system can provide a brief abstract of each information record along with an estimated likelihood that the information record an is relevant to the inquiry*).

As per claim 5, Covington teaches the limitation:

“wherein the step of categorizing comprises signing up on a website as a categorizer and categorizing a plurality of items corresponding to one or more of the

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plurality of predetermined categories" (Paragraph 0017, i.e., *a User can be an employee of the customer, and the customer can be the **subscribing party***; Paragraph 0047, i.e., *the Database Reviewers may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information.;* and Paragraph 0047, i.e., *In one embodiment of the invention, Database Reviewer **adds additional categories** and structures to the proposed database prior to adding the new information to the database).*

As per claim 6, Covington teaches the limitation:

"further comprising charging a fee for initiating the search for the one or more items" (Paragraph 0017, i.e., *a User can be an employee of the customer, and the customer can be the **subscribing party***).

As per claim 19 Covington teaches the limitations:

"accessing a web site by an authorized categorizer" (Paragraph 0047, i.e., *the Database Reviewers may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information.;*);

"identifying the item to be categorized" (Paragraph 0047, i.e., *the Database Reviewers may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information.;*);

"selecting a category from a plurality of predetermined categories stored in a database accessible by the web site" (Paragraph 0047, i.e., *the Database Reviewers*

*may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information.; and Paragraph 0047, i.e., In one embodiment of the invention, Database Reviewer **adds additional categories and structures to the proposed database prior to adding the new information to the database**);*

“applying the selected category to the identified item” (Paragraph 0047, i.e., the Database Reviewers may categorize the information in such manner that any search term concerning sexual harassment would yield the newly created information); and

“storing the identified item and the applied category in the database” (Figure 3 and Paragraph 0014, i.e., Fig. 3 is a process diagram for updating one or more databases according to one embodiment of the invention).

Claim 20 is rejected on the same basis as claim 2.

Claim 21 is rejected on the same basis as claim 1.

Claim 22 is rejected on the same basis as claim 3.

Claim 23 is rejected on the same basis as claim 4.

Claim 28 is rejected on the same basis as claim 1.

Claim 29 is rejected on the same basis as claim 2.

Claim 30 is rejected on the same basis as claim 3.

Claim 31 is rejected on the same basis as claim 4.

Claim 32 is rejected on the same basis as claim 5.

Claim 33 is rejected on the same basis as claim 6.

Claim 38 is rejected on the same basis as claim 19.

Claim 39 is rejected on the same basis as claim 20.

Claim 40 is rejected on the same basis as claim 21.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-15, 17, 25-27, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Robinson (hereinafter "Robinson") (U.S. Patent Number 7072846).

As per claim 7, Covington does not explicitly teach the limitation: "further comprising assigning points to a categorizer based on number of users who have searched an item categorized by the categorizer".

Robinson teaches the limitation:

"further comprising assigning points to a categorizer based on number of users who have searched an item categorized by the categorizer" (Column 3 Lines 49-55, i.e., *Reviewers can be paid similarly for access to reviews written by that reviewer*). Points based on number of users who searched an item categorized by the categorizer/reviewer are inherent in this disclosure.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art combine the method of Covington, for categorizing by reviewers/categorizers, with the method of Robinson, for rewarding reviewers based on user access, so that the combined method would comprise assigning points to a categorizer based on number of users who have searched an item categorized by the categorizer. One would have been motivated to do so in order to *enable consumers more efficiently find artists and entertainers they will enjoy* (Robinson, Column 1 Lines 25-30).

As per claim 8, Robinson teaches the limitation:

"further comprising compensating the categorizer based on the assigned points" (Column 3 Lines 49-55, i.e., *Reviewers can be paid similarly for access to reviews written by that reviewer*).

As per claim 9, Robinson teaches the limitation:

“further comprising positioning the categorizer on a favorable screen position of a display screen, based on the assigned points to the categorizer” (Column 3 Lines 14-25, i.e., *The system can use these ratings to determine the quality of a reviewer in general and/or the degree to which each individual user likes a particular reviewer. These factors can be used together with the similarity data, or in some embodiments, without it, to determine ordering of reviews*).

As per claim 10, Robinson teaches the limitation:

“further comprising displaying a list of categorizers on a display screen” (Column 3 Lines 14-25, i.e., *The system can use these ratings to determine the quality of a reviewer in general and/or the degree to which each individual user likes a particular reviewer*). Note that ratings are lists and list of reviews/categorizers are inherent.

As per claim 11, Robinson teaches the limitations:

“wherein the list of categorizers displayed on the display screen is ordered based on one or more of a respective categorizer's overall popularity within the selected category, a respective categorizer's recent popularity within the selected category, a

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respective categorizer's overall popularity within a broader subject area than the selected category, a respective categorizer's recent popularity within a broader subject area than the selected category, a respective categorizer's reliability within a user-specified subject area, and a respective categorizer's reliability within a broad subject area" (Column 3 Lines 14-25, i.e., *The system can use these ratings to determine the quality of a reviewer in general and/or the degree to which each individual user likes a particular reviewer*).

As per claim 12, Robinson teaches the limitation:

"wherein at least one of the plurality of predetermined categories relates to music" (Column 1 Lines 56-61, i.e., *will focus on music applications*).

As per claim 13, Robinson teaches the limitation:

"wherein at least one of the plurality of predetermined categories relates to movies" (Column 1 Lines 56-61, i.e., *fields of writings and movies*).

As per claim 14, Robinson teaches the limitation:

"wherein at least one of the plurality of predetermined categories relates to books" (Column 1 Lines 56-61, i.e., *fields of writings and movies*).

As per claim 15, Official Note is taken that reviewing/categorizing web pages is notoriously well known in the art.

As per claim 17, Robinson teaches the limitation:

“wherein at least one of the plurality of predetermined categories relates to product or services” (Column 1 Lines 25-30, i.e., *Online services based on this invention will enable artists and entertainers to more efficiently find the consumers*).

Claim 25 is rejected on the same basis as claim 7.

Claim 26 is rejected on the same basis as claim 8.

Claim 27 is rejected on the same basis as claim 9.

Claim 34 is rejected on the same basis as claim 7.

Claim 35 is rejected on the same basis as claim 8.

Claim 36 is rejected on the same basis as claim 9.

Claim 37 is rejected on the same basis as claim 17.

8. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Edwards et al., (hereinafter "Edwards") (U.S. Patent Application Publication Number 2002/0038430).

As per claim 16, teaches the limitation: "at least one of the plurality of predetermined categories" (Paragraph 0010, i.e., *Next the system associates the inquiry with one or more predefined categories and provides one more possible responses to the inquiry based on the available information*). Covington does not explicitly teach the limitation: "relates to security or intelligence content".

Edwards teaches the limitation:

"relates to security or intelligence content" (Paragraph 0016, i.e., *The analyst reviews the new intelligence data*).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add security of intelligence content as an category to the categories taught by Covington so that in the resultant method at least one of the plurality of predetermined categories relates to security or intelligence content. One would have been motivated to do so in order to *monitor security threats* (Edwards Paragraph 0004).

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9. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Gonzales (hereinafter "Gonzales") (U.S. Patent Application Publication Number 2002/0152087).

As per claim 18, Covington does not explicitly teach the limitation: "wherein the product or the service is one or more of art, craft, wine, cheese, beer, plumbing, air conditioning, auto repair, haircutting, legal service, and medical service".

Gonzales teaches the limitation:

"wherein the product or the service is one or more of art, craft, wine, cheese, beer, plumbing, air conditioning, auto repair, haircutting, legal service, and medical service" (Gonzales, Paragraph 0106).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add products and services taught by Gonzales to the method of Covington so that the resultant method would comprise said products and services. One would have been motivated to do so because it is well known in the art that said products and services are offered on Internet with expert reviews.

10. Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Boyd (hereinafter "Boyd") (U.S. Patent Application Publication Number 2002/0194049).

As per claim 24, Covington does not explicitly teach the limitation: "comprising charging the categorizer a fee for categorizing the item".

Boyd teaches the limitation"

“comprising charging the categorizer a fee for categorizing the item” (Paragraph 0052, i.e. *charging users with a fee for posting to post an invitation and/or review*).

Note that the method and system of Boyd teaches charging a fee to users for posting something on a service web site just as the claimed invention charges categorizers for posting their categories.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the feature of charging a fee for posting on a service web site as taught by Boyd to the method of Covington so that the resultant would comprise charging the categorizer a fee for categorizing the item. One would have been motivated to do so because charging a fee for posting on a service/product web site is well known in the art.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows.

U.S. Application Publication Number 2003/0074516 (Cho et al.)

U.S. Application Publication Number 2003/0195863 (Marsh)

U.S. Application Publication Number 2002/0154157 (Sherr et al.)

U.S. Application Publication Number 2001/0003828 (Peterson et al.)

U.S. Application Publication Number 2003/0115550 (Womble et al.)

U.S. Application Publication Number 2003/0158872 (Adams)

U.S. Application Publication Number 2001/0025259 (Rouchon)

U.S. Application Publication Number 2002/0049738 (Epstein)

U.S. Application Publication Number 2002/0169851 (Weathersby et al.)

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Myint whose telephone number is (571) 272-5629. The examiner can normally be reached on 8:30AM-5:30PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-5629.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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